

Remarks

In the Office Action mailed on October 27, 2004 by the United States Patent and Trademark Office, the Examiner rejected claims 1-14. By way of this Response and Amendment, Applicant has cancelled claims 3, 5, and 15-32 without disclaimer or prejudice, amended claims 1, 2, 4, 6, 7, 10, 11, 12, and 14, and added new claim 33. After entry of these amendments, claims 1, 2, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, and 33 remain in the above-identified patent application. Reconsideration is respectfully requested in light of the foregoing amendments and the following remarks. The foregoing amendments and the following remarks are believed to be fully responsive to the Office Action mailed on October 27, 2004.

I. REJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH

The Examiner rejected claims 1-2 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that “improved material quality” make these claims indefinite.

In view of the Examiner’s rejections, claim 1 and claim 2 has been amended to remove the claim language that “the plurality of magnetic layers has improved material quality,” and claim 1 has been amended to introduce language that provides a relationship between the thicknesses of the two magnetic layers. It is respectfully submitted these amendments overcome the rejections under 35 U.S.C. 112, second paragraph. Accordingly, the Applicants respectfully request the Examiner withdraw the rejection of claims 1-2 under 35 U.S.C. 112, second paragraph.

II. REJECTIONS UNDER 35 U.S.C. 102

The Examiner rejected claims 1 and 6-11 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,166,948 as issued to Parkin et al on December 20, 2000 (hereinafter “Parkin”) or under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,545,906 as issued to Savtchenko et al on April 8, 2003 (hereinafter referred to as “Savtchenko”). In addition, the Examiner rejected claims 5, 12, and 14 under 35 U.S.C. 102(b) as being anticipated by Parkin. Furthermore, the Examiner rejected claim 13 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No.

6,567,246 as issued to Sakakima et al on May 20, 2003 (hereinafter referred to as "Sakakima"). Applicants respectfully traverse these rejections.

In order to clarify Applicants' invention, independent claim 1 has been amended to recite "a first magnetic layer having a first thickness" and "a second magnetic layer positioned adjacent to the nonmagnetic spacer region" that has "a second thickness that is greater than the first thickness." It is respectfully submitted that Parkin, Savtchenko, Sakakima or any of the references of record do not teach, disclose or suggest a relationship between the thickness of a first magnetic layer and a thickness of a second magnetic layer that is positioned adjacent to the nonmagnetic spacer region with the thickness of the second magnetic layer greater than the thickness of the first magnetic layer. Accordingly, claim 1 and the claims that depend from independent claim 1 (i.e., claims 2, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, and 33) are not anticipated by Parkin, Savtchenko, Sakakima or any of the references or record. Therefore, the Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. 102(b) or 35 U.S.C. 102(e).

III. REJECTIONS UNDER 35 U.S.C. 103

The Examiner rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over Parkin and in view of further remarks set forth in the first paragraph of page 11 of the Office Action mailed on October 27, 2004. In addition, the Examiner rejected claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Parkin in view of U.S. Patent No. 6,205,052 as issued to Slaughter et al on March 20, 2001 (hereinafter referred to as "Slaughter"). Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify a reference or to combine the teachings of multiple references. Second, there must be a reasonable expectation of success. Third, the prior art must teach or suggest all of the recited claim limitations. Of course, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. Applicant respectfully submits that the Examiner has not met the basic criteria to establish a *prima facie* case of obviousness.

For example, it is respectfully submitted that the prior art does not teach or suggest all of the recited limitations of the amended claims. As previously set forth in the discussion of the rejections

under 35 U.S.C. 102, independent claim 1 has been amended to recite “a first magnetic layer having a first thickness” and a second magnetic layer positioned adjacent to the nonmagnetic spacer region” that has “a second thickness that is greater than the first thickness.” It is respectfully submitted that Parkin or Slaughter do not individually or jointly teach disclose or suggest a relationship between the thickness of a first magnetic layer and a thickness of a second magnetic layer that is positioned adjacent to the nonmagnetic spacer region with the thickness of the second magnetic layer greater than the thickness of the first magnetic layer. Accordingly, all the limitations of independent claim 1 and the claims that depend from independent claim 1 (i.e., claims 2, 4, 6, 7, 8, 9, 10, 11, 12, 13, 14, and 33) are not taught or suggested and a *prima facie* case of obviousness cannot be established without all of these limitations. Therefore, it is respectfully submitted that a *prima facie* case of obviousness does not exist and the Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. 103.


IV. CONCLUSION

Applicant respectfully submits that the above-identified application as amended is now in condition for allowance and the Applicant therefore earnestly requests such allowance. Should the Examiner have any questions or wish to discuss the foregoing response and amendment, Applicant requests that the Examiner contact the undersigned at (480) 385-5060.

If for some reason Applicant have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 50-2091 for any fee which may be due.

Respectfully submitted,

Dated: 01/27/05

By: 
Timothy J. Lorenz
Reg. No. 41,954

Ingrassia, Fisher & Lorenz, P.C.
7150 E. Camelback Rd., Suite 325
Scottsdale, Arizona 85255
Phone: (480) 385-5060
Fax: (480) 385-5061
Customer No. 29906